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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,538	09/19/2003	Bradley Berman	KING.005C1	5905
29159	7590	01/02/2008		
BELL, BOYD & LLOYD LLP			EXAMINER	
P.O. Box 1135			HSU, RYAN	
CHICAGO, IL 60690			ART UNIT	PAPER NUMBER
			3714	
			NOTIFICATION DATE	DELIVERY MODE
			01/02/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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PATENTS@BELLBOYD.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/666,538	<b>Applicant(s)</b> BERMAN ET AL.	
	<b>Examiner</b> Ryan Hsu	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 is/are allowed.
- 6) ☒ Claim(s) 1-26 and 28-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

In response to the Request for Continued Examination (RCE) under 37 CFR 1.114 filed on 10/30/07. In response to the amendments filed on 10/30/07, claims 1, 24, 27, 34, and 35 have been amended. Claims 1-39 are pending in the current application.

#### *Allowable Subject Matter*

Claim 27 is allowed.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-84 of U.S. Patent No. 6,634,945 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant application are directed towards a method of facilitating a play of a slot game after placement of a wager that presents in the play of the slot game symbols in active reel

segments. The claims of the instant invention also provide an award based on the symbols presented in each of the active reels segments and deactivates the active reel segments when an associated discontinue symbol appears. The system then repeats this process until a predetermined number of active reel segments have been deactivated. The claims of U.S. Patent No. 6,634,945 are also directed towards independently activated reels wherein the plurality of award symbols is associated with each of the award symbols. Furthermore, the device found in '945 has reels that are deactivated upon a terminating condition and then repeats the process of spinning the devices until each of the reels are de-activated. As a result there two sets of claims are not patentably distinct from one another as they currently describe the same invention and method of activating and deactivating game reels in a gaming device. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to present the claims of the instant invention at the time the claims of patent '945 were presented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-26 and 28-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Glavich et al. (US 6,634,945 B2).**

Regarding claims 1, 24, and 34-35, Glavich discloses a method for facilitating a play of a slot game after placement of a wager comprising: a video screen to present, in a play of the game, a display grid having a plurality of display cells and a user interface to facilitate player participation in at least the standard mode of operation (*see Fig. 1-2 and the related description thereof*). Additionally, Glavich discloses a processor programmed to a) present, in the play of the slot game, a display grid comprising a plurality of active display segments (*see Fig. 4(a-d) and the related description thereof*); b) presenting symbols in each of the active display segments (*see Fig. 4(a-d) and the related description thereof*); c) providing an award, if any, based on the symbols present in each of the active display segments (*see Fig. 4(a-d) and the related description thereof*); d) deactivating the active display segments that are associated with a discontinue symbol (*see Fig. 4(a-d) and the related description thereof*) determining which active display segments, if any, have been deactivated; and f) repeating steps b) to e) in the same play of the slot game without placement of another wager until a predetermined number of active display segments have been deactivated (*see Fig. 4(a-d) and the related description thereof*).

Regarding claim 36-39, Glavich discloses a method wherein the deactivated reel segments are prevented from presenting another symbol in the same play of the game (*see abstract7*). Additionally, the deactivated reels are prevented from presenting another symbol in the same play of the game (*see abstract*).

Regarding claims 2-3, 20-24, and 34, Glavich discloses a game machine that presents a reel configuration comprising a plurality of active reel segments that are able to provide an award based on the symbols presented in each of the active reel segments and deactivates the active reel segments that are associated with the discontinue symbol. Additionally, Glavich

discloses determining which active reel segments have been deactivated or become “persistent” symbols and repeats the play of the slot game until a predetermined number of active reel segments or games have been played (*see Figs. 4(a-d) and the related description thereof*). Furthermore, Glavich presents a video screen to present, in the play of the game a display grid having a plurality of display cells and a user interface to facilitate player participation in at least the standard mode of operation. Glavich also teaches incorporating a processor programmed to (i) identify a predetermined symbol combination occurring on the display grid during the standard mode of operation to activate the bonus mode of operation, and during the bonus mode of operation in the same play of the game the processor (*see Figs. 4(a-d) and the related description thereof*) is programmed to: (ii) randomly present symbols which includes one or more active reels having corresponding reels strips, (iii) provide an award, if any, based on the symbols randomly presented via any of the active reels (*see Fig. 1(a-b)-2 and the related description thereof*), (iv) deactivate any of the active reels presenting a discontinue symbol (*see Figs. 4(a-d) and the related description thereof*), v) determine which active reels have been deactivated (*see Figs. 4(a-d) and the related description thereof*) and vi) repeat the random presentation of symbols, the provision of an award, if any, the deactivation of the reels associated with the discontinue symbol and the determination of which reels have been deactivated until a predetermined number of reels have been deactivated (*see Figs. 4(a-d) and the related description thereof*). Additionally, Glavich discloses a method wherein repeatedly presenting symbols comprises automatically repeating presenting symbols and deactivating the active reel segments until all of the active reel segments have been deactivated (*see Figs. 4(a-d) and the related description thereof*). Additionally, the repeated presenting symbols comprise of

providing a user interface to allow a participant to initiate each repeated presentation of symbols until all of the active reel segments have been deactivated (*see Figs. 4(a-d) and the related description thereof*). Furthermore, the repeated presentation of symbols and deactivating the active reel segments until a predetermined number of the active reel segments have been deactivated comprises deactivating the active reel segments until all of the active reel segments have been deactivated (*see Figs. 4(a-d) and the related description thereof*).

Regarding claims 2-3, Glavich discloses a game machine wherein presenting a mechanical reel configuration comprising a plurality of active reel segments comprises presenting the active reel segments (*see Figs. 4(a-d) and the related description thereof*). Glavich also teaches a bonus mode of play in response to presentation of a symbol combination during a standard mode of play that invokes the bonus mode of play and a bonus symbol set comprising the symbols presented in each of the active reel segments during the bonus mode of play is different than a standard symbol set comprising standard symbols presented in the reel configuration during the standard mode of play (*see Figs. 4(a-d) and the related description thereof*). Furthermore, Glavich teaches of a secondary reel set that is different than the standard symbol set comprising standard symbols presented in the mechanical reel configuration of the standard mode of play (*see Figs. 4(a-d) and the related description thereof*).

Regarding claims 4-6, Glavich discloses a system where at least partially randomly selecting which symbol is to be presented in each of the active reel segments (*see Figs. 4(a-d) and the related description thereof*). Additionally, Glavich discloses a game system where the symbol is presented comprises an associated reel strip having a predetermined symbol set to each of the active reel segments (*see Figs. 4(a-d) and the related description thereof*). Furthermore,

Glavich discloses a game system wherein associating a reel strip having a predetermined symbol set to each of the active reel segments comprises associating a different reel strip to each of the active reel segments (*see Figs. 4(a-d) and the related description thereof*).

Regarding claims 7-8, Glavich discloses a system wherein at least partially randomly selecting which symbol is to be presented comprises associating a predetermined symbol set to a plurality of the active reel segments (*see Figs. 4(a-d) and the related description thereof*).

Regarding claims 9-10, Glavich discloses a method wherein at the active reel segments that are deactivated by being associated with a discontinue symbol are de-emphasized to be distinguished from the active reel segments (*see Fig. 4(a-d) and the related description thereof*).

Regarding claims 11-15, Glavich discloses a method wherein presenting symbols in each of the active reel segments comprises presenting continue symbols in one or more of the active reel segments, wherein the continue symbols direct its respective one of the active reel segments to remain active (*see Fig. 4(a-d) and the related description thereof*). Additionally, the method comprises associated a credit award with one or more of the continue symbols and implementing a credit award with one or more of the continue symbols. Furthermore, the credit award may have a positive, negative or null effect on an accumulated credit total (*see Fig. 11: ln 1-col. 12: ln 13*)

Regarding claims 16-19, Glavich discloses a method comprising associating a credit award with one or more of the discontinue symbols. Where the discontinue symbols may have an additive effect a negative effect or a null effect on an accumulated credit total (*ie: win or lose credit award of wager lost or gained based on predetermined payout scheme*) (*see Figs. 4(a-d) and the related description thereof*).



Regarding claim 25, Glavich discloses a casino game wherein the processor comprises a random number generator configured to randomly select the symbols for presentation via the reels (*see col. 7: ln 55-col. 10: ln 5*).

Regarding claim 26, Glavich discloses a user interface that comprises a user interface mechanism to allow the player to initiate each repetition of the random presentation of symbols (*see Fig. 4(a-d) and the related description thereof*).

Regarding claims 29-32, Glavich disclose a casino gaming apparatus wherein the casino gaming apparatus comprises a slot machine, a video poker machine, a video bingo machine, and a keno machine as the standard mode of operation of the gaming machine (*see col. 6: ln 5-35*).

Regarding claim 33, Glavich disclose a casino gaming apparatus wherein the processor is programmed to repeat the random presentation of symbols and deactivation of the reels associated with the discontinue symbols until all of the reels have been deactivated (*see Figs. 4(a-d) and the related description thereof*).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

#### ***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

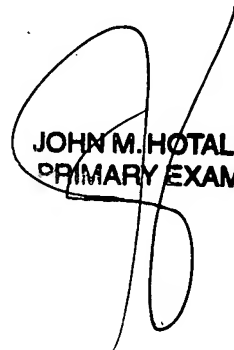
Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E Pezzuto can be reached at (571)-272-6996.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

  
RH

December 21, 2007

  
**JOHN M. HOTALING, II**  
**PRIMARY EXAMINER**